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EXAMINER

YOUNG, JOHN L

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/688,694

Applicant(s)
Lefebvre et al.,

Examiner
John Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 17, 2000
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2-4 6) ☐ Other:

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FIRST ACTION REJECTION

DRAWINGS

1. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

Antecedent Basis and Inferential Claiming

2. Claims 5-9 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

As per claim 5, said claim at line 1 suffers from inferential claiming, and there is no explicit antecedent basis in the claim for “the incentive matrix further comprises. . . .”

Claims 6-9 are rejected for substantially the same reasons.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shurling 6,009,415 (12/28/1999) (herein referred to as “Shurling”).

As per claim 1, Shurling (the ABSTRACT; FIG. 2; FIG. 3; FIG. 1; FIG. 4; FIG. 5; FIG. 6A; FIG. 6B; FIG. 6C; FIG. 7B; FIG. 8; FIG. 9; FIG. 10A; FIG. 10B; FIG. 11A; FIG. 11B; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-11; col. 6, ll. 25-37; col. 8, ll. 50-67; col. 15, ll. 47-67; col. 16, ll. 38-67; col. 17, ll. 1-67; and col. 18, ll. 1-15) shows “A system for presenting incentives specially tailored to a customer, comprising: an interactive user application running on a computer, said computer having a display operatively connected to said computer; a customer segmentation module for characterizing the customer; a product segmentation module for characterizing one or more products associated with the customer; a call type module for characterizing the purpose of the call; and an incentive

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module for processing information related to one or more of the customer segmentation module, the card segmentation module, and the call type module to formulate a set of incentives to offer to the customer.”

Shurling lacks an explicit recitation of “A system for presenting incentives specially tailored to a customer, comprising: an interactive user application running on a computer, said computer having a display operatively connected to said computer; a customer segmentation module for characterizing the customer; a product segmentation module for characterizing one or more products associated with the customer; a call type module for characterizing the purpose of the call; and an incentive module for processing information related to one or more of the customer segmentation module, the card segmentation module, and the call type module to formulate a set of incentives to offer to the customer. . . .” even though Shurling suggests same.

It would have been obvious to a person of ordinary skill in the art of secure electronic transactions that the disclosure of Shurling (the ABSTRACT; FIG. 2; FIG. 3; FIG. 1; FIG. 4; FIG. 5; FIG. 6A; FIG. 6B; FIG. 6C; FIG. 7B; FIG. 8; FIG. 9; FIG. 10A; FIG. 10B; FIG. 11A; FIG. 11B; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-11; col. 6, ll. 25-37; col. 8, ll. 50-67; col. 15, ll. 47-67; col. 16, ll. 38-67; col. 17, ll. 1-67; and col. 18, ll. 1-15) would have been selected in accordance with “A system for presenting incentives specially tailored to a customer, comprising: an interactive user application running on a computer, said computer having a display operatively connected to said computer; a customer segmentation module for characterizing the customer; a product segmentation

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module for characterizing one or more products associated with the customer; a call type module for characterizing the purpose of the call; and an incentive module for processing information related to one or more of the customer segmentation module, the card segmentation module, and the call type module to formulate a set of incentives to offer to the customer. . . .” because such selection would have provided means for “*attracting and retaining long-term customers. . . .*” (See Shurling (col. 2, ll. 33-40)).

As per claim 2, Shurling shows the system of claim 1. (See the rejection of claim 1 supra).

Shurling (the ABSTRACT; FIG. 2; FIG. 3; FIG. 1; FIG. 4; FIG. 5; FIG. 6A; FIG. 6B; FIG. 6C; FIG. 7B; FIG. 8; FIG. 9; FIG. 10A; FIG. 10B; FIG. 11A; FIG. 11B; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-11; col. 6, ll. 25-37; col. 8, ll. 50-67; col. 15, ll. 47-67; col. 16, ll. 38-67; col. 17, ll. 1-67; and col. 18, ll. 1-15) shows “wherein the product is a product offered by a financial institution.”

Shurling lacks an explicit recitation of “wherein the product is a product offered by a financial institution. . . .” even though Shurling reasonably suggests same.

It would have been obvious to a person of ordinary skill in the art that the disclosure of Shurling (the ABSTRACT; FIG. 2; FIG. 3; FIG. 1; FIG. 4; FIG. 5; FIG. 6A; FIG. 6B; FIG. 6C; FIG. 7B; FIG. 8; FIG. 9; FIG. 10A; FIG. 10B; FIG. 11A; FIG. 11B; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-11; col. 6, ll. 25-37; col. 8, ll. 50-67; col. 15, ll. 47-67; col. 16, ll. 38-67; col. 17, ll. 1-67; and col. 18, ll. 1-15) would have been selected

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in accordance with “wherein the product is a product offered by a financial institution. . . .” because such selection would have provided means for “*attracting and retaining long-term customers. . . .*” (See Shurling (col. 2, ll. 33-40)).

As per claim 3, Shurling shows the system of claim 1. (See the rejection of claim 1 supra).

Shurling (the ABSTRACT; FIG. 2; FIG. 3; FIG. 1; FIG. 4; FIG. 5; FIG. 6A; FIG. 6B; FIG. 6C; FIG. 7B; FIG. 8; FIG. 9; FIG. 10A; FIG. 10B; FIG. 11A; FIG. 11B; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-11; col. 6, ll. 25-37; col. 8, ll. 50-67; col. 15, ll. 47-67; col. 16, ll. 38-67; col. 17, ll. 1-67; and col. 18, ll. 1-15) shows “wherein the customer segmentation module assigns a value to the customer based on the customer’s payment history.”

Shurling lacks an explicit recitation of “wherein the customer segmentation module assigns a value to the customer based on the customer’s payment history. . . .” even though Shurling reasonably suggests same.

It would have been obvious to a person of ordinary skill in the art that the disclosure of Shurling (the ABSTRACT; FIG. 2; FIG. 3; FIG. 1; FIG. 4; FIG. 5; FIG. 6A; FIG. 6B; FIG. 6C; FIG. 7B; FIG. 8; FIG. 9; FIG. 10A; FIG. 10B; FIG. 11A; FIG. 11B; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-11; col. 6, ll. 25-37; col. 8, ll. 50-67; col. 15, ll. 47-67; col. 16, ll. 38-67; col. 17, ll. 1-67; and col. 18, ll. 1-15; and whole document) would have been selected in accordance with “wherein the customer segmentation

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module assigns a value to the customer based on the customer's payment history. . . .”
because such selection would have provided means for “*attracting and retaining long-term customers. . . .*” (See Shurling (col. 2, ll. 33-40)).

As per claim 4, Shurling shows the system of claim 3. (See the rejection of claim 3 supra).

Shurling (the ABSTRACT; FIG. 2; FIG. 3; FIG. 1; FIG. 4; FIG. 5; FIG. 6A; FIG. 6B; FIG. 6C; FIG. 7B; FIG. 8; FIG. 9; FIG. 10A; FIG. 10B; FIG. 11A; FIG. 11B; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-11; col. 6, ll. 25-37; col. 8, ll. 50-67; col. 15, ll. 47-67; col. 16, ll. 38-67; col. 17, ll. 1-67; and col. 18, ll. 1-15) shows “wherein one or more indicators are associated with the value wherein the indicators vary in appearance and provide an indication of profitability.”

Shurling lacks an explicit recitation of “wherein one or more indicators are associated with the value wherein the indicators vary in appearance and provide an indication of profitability. . . .” even though Shurling reasonably suggests same.

It would have been obvious to a person of ordinary skill in the art that the disclosure of Shurling (the ABSTRACT; FIG. 2; FIG. 3; FIG. 1; FIG. 4; FIG. 5; FIG. 6A; FIG. 6B; FIG. 6C; FIG. 7B; FIG. 8; FIG. 9; FIG. 10A; FIG. 10B; FIG. 11A; FIG. 11B; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-11; col. 6, ll. 25-37; col. 8, ll. 50-67; col. 15, ll. 47-67; col. 16, ll. 38-67; col. 17, ll. 1-67; and col. 18, ll. 1-15; and whole document) would have been selected in accordance with “wherein one or more indicators are

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associated with the value wherein the indicators vary in appearance and provide an indication of profitability. . . .” because such selection would have provided means for *“attracting and retaining long-term customers. . . .”* (See Shurling (col. 2, ll. 33-40)).

As per claims 5-9, Shurling shows the system of claim 1 and subsequent base claims depending from claim 1. (See the rejection of claim 1 supra).

Shurling lacks an explicit recitation of the elements and limitations of claims 5-9, even though Shurling (the ABSTRACT; FIG. 2; FIG. 3; FIG. 1; FIG. 4; FIG. 5; FIG. 6A; FIG. 6B; FIG. 6C; FIG. 7B; FIG. 8; FIG. 9; FIG. 10A; FIG. 10B; FIG. 11A; FIG. 11B; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-11; col. 6, ll. 25-37; col. 8, ll. 50-67; col. 15, ll. 47-67; col. 16, ll. 38-67; col. 17, ll. 1-67; and col. 18, ll. 1-15; and whole document) suggests same.

“Official Notice” is taken that both the concepts and the advantages of the elements and limitations of claims 5-9 were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and the advantages would have facilitated for *“attracting and retaining long-term customers. . . .”* (See Shurling (col. 2, ll. 33-40)).

Independent claim 10 is rejected for substantially the same reasons as independent claim 1.

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Claim 11 is rejected for substantially the same reasons as claim 2.

Claim 12 is rejected for substantially the same reasons as claim 3.

Claim 13 is rejected for substantially the same reasons as claim 4.

Claims 14-18 are rejected for substantially the same reasons as claims 5-9.

CONCLUSION

4. Any response to this action should be mailed to:

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Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or

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Hand delivered responses may be brought to:

Seventh floor Receptionist
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2451 Crystal Drive
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


John L. Young
Patent Examiner

June 1, 2003